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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,494	12/27/2000	Richard Friedman	60000.001US	6960
31955	7590	08/13/2004	EXAMINER	
CAPSTONE LAW GROUP LLP 1810 GATEWAY DRIVE SUITE 260 SAN MATEO, CA 94404			HAMILTON, LALITA M	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/750,494

Applicant(s)

FRIEDMAN ET AL.

Examiner

Lalita M Hamilton

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 113 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Objections

Claims 1-3 are objected to because of the following informalities: In claim 1, after "against", "of the" is unclear. The "of" should be deleted. Claims 2-3 are objected for their dependency upon claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

Claims 9-13 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap *two* different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a method (ex. preamble of claim 9—"comprising the steps of:") and subsequently, the body of the claim discusses the specifics of the analyzing system. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Mason (US 2001/0051918).

Mason discloses a system and corresponding method for disallowing payments for e-billing comprising data input means for receiving the telecommunications bills, means for storing a database of pre-determined billing indices, a processor including means for comparing the billed indices from the telecommunications bill against of the pre-determined indices, means for identifying billing discrepancies between the billed indices and the pre-determined indices, and means for generating deprovision requests and billing disputes based upon the billing discrepancies; and data output means for transmitting the deprovision requests and the billing disputes (p.2-3, 25; p.3, 29-32; and fig.2-all); the processor further includes means for determining and correcting errors in the database of pre-determined billing indices (p.3, 29-31); the processor further includes means for identifying installed telecommunication components that are not

included as the billed telecommunication items and for accruing the un-included installed telecommunication components (p.3, 29-31—during audit); a method for analyzing billing items in telecommunications bills received by a consumer from a vendor, comprising the steps of extracting data from the telecommunication bills, identifying non-existent billing item components in the telecommunication bills by comparing the billing item components in the telecommunication bills to an existing component database, determining erroneous billing item rates in the telecommunication bills by comparing the billing item rates in the telecommunication bills to rate data stored in a rate database, determining erroneous billing item quantities in the telecommunications bills by comparing the billing item quantities in the telecommunication bills to quantity data stored in a quantity database, and generating a billing dispute for the billing items based upon the non-existent billing item components, erroneous billing item rates and erroneous billing item quantities (p.2-3, 25; p.3, 29-32; and fig.2-all---It is inherent that the billing item rates and quantities in the bills will be compared to stored rate and quantity data during the auditing process to correct billing errors); generating deprovision requests to the vendors based upon the non-existent billing item components (p.3, 29-31); determining and correcting errors in the existing component database (p.3, 29-31—during audit); identifying installed components from the existing component database that are not included as billing item components in the telecommunication bills and accruing the un-included installed components (p.3, 29-31—during audit); the quantity database contains component usage and component configuration data (p.2-3, 25; p.3, 29-32; and fig.2-all); a existing component database

containing data identifying existing components, a rate database containing data identifying billing rates for the existing components, a quantity database containing data identifying quantities of the existing components, means for receiving and extracting data from the telecommunication bills, means for comparing the billing item components in the telecommunication bills to the existing component database to identify non-existent billing item components in the telecommunication bills, means for comparing the billing item rates in the telecommunication bills to the rate database to determine erroneous billing item rates in the telecommunication bills, means for comparing the billing item quantities in the telecommunication bills to the quantity database to determine erroneous billing item quantities in the telecommunication bills, and means for disputing the billing items based upon the non-existent billing item components, erroneous billing item rates, and erroneous billing item quantities (p.2-3, 25; p.3, 29-32; and fig.2-all---It is inherent that the billing item rates and quantities in the bills will be compared to stored rate and quantity data during the auditing process to correct billing errors); means for generating dep provision requests to the vendors based upon the non-existent billing item components (p.3, 29-31); means for determining and correcting errors in the existing component database (p.3, 29-31); means for identifying installed components from the existing component database that are not included as billing item components in the telecommunication bills and means for accruing the un-included installed components in an accounting system of the consumer (p.3, 29-31—during audit); and the quantity database contains component usage and component configuration data (p.2-3, 25; p.3, 29-32; and fig.2-all).

Provisional Application Listed on PTO-892 form

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

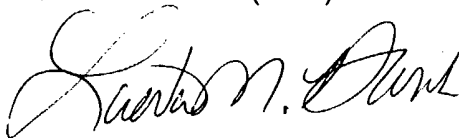
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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